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Docket No.: 1080.1092

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

Yosuke KONAKA

Serial No. 09/781,324

Group Art Unit: 2116

Confirmation No. 9071

Filed: February 13, 2001

Examiner: Nitin C. Patel

For: **ELECTRONIC APPARATUS AND PROCESSING ABILITY ALTERATION  
INSTRUCTION APPARATUS**

**REPLY BRIEF UNDER 37 C.F.R §41.41**

Mail Stop Reply Brief-Patents  
Commissioner for Patents  
PO Box 1450  
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Sir:

This is in response to the Examiner's Answer mailed June 30, 2005. A Reply Brief is due August 30, 2005. The Applicant responds below to certain points raised by the Examiner in the Examiner's Answer.

**The Claims Are Directed To Maintaining An Electronic Apparatus In An Operative State By Lowering the Processing Ability Of The Electronic Apparatus When Batteries Are Removed**

On page 13 of the Examiner's Answer, the Examiner correctly stated Applicant's argument that none of the prior art teaches or suggests a feature wherein "even if some batteries are removed, the apparatus is maintained in an operative state by lowering the processing ability of the electronic apparatus." The Examiner then took the position that this feature is not recited in the claims. Applicant disagrees.

In particular, while this precise language is not set forth in the claims, it is submitted that the claims explicitly set forth a structure such that the electronic apparatus is maintained in an operative state by lowering the processing ability even if some batteries are removed.

For example, claim 1 recites “a removal requirement receipt section receiving a removal requirement for a part of the mounted batteries.” This feature clearly contemplates removal of some but not necessarily all of the batteries in the electronic apparatus.

Claim 1 further recites “a processing ability determination section responsive to the removal requirement for a battery from said removable requirement receipt section to determine whether a supplying possible electric power from the remaining batteries is an electric power capable of maintaining a processing ability or an electric power which needs to lower the processing ability.” Thus, when a battery is to be removed, the processing ability determination section determines whether it is necessary to lower the processing ability of the electronic apparatus.

Finally, claim 1 recites “a processing ability control section lowering the processing ability while keeping the electronic apparatus operative in accordance with a decision from said processing ability determination section that the electric power needs to lower the processing ability.” This specifies that the processing ability is lowered based on the remaining electronic power supplied by the remaining batteries.

In summary, it is submitted that the recitations of claim 1 are clearly directed to a feature wherein “even if some batteries are removed, the apparatus is maintained in an operative state by lowering the processing ability of the electronic apparatus.”

#### **Takizawa and Pole Do Not Teach The Claimed “Processing Ability Determination Section”**

Contrary to the Examiner’s position on page 13 of the Examiner’s Answer, it is submitted that neither Takizawa nor Pole teach or suggest the claimed “processing ability determining section.”

Specifically, the prior art does not teach or suggest a processing ability determination section to determine whether the power supplied from the remaining batteries is an electric power which needs to lower the processing ability as set forth in claim 1, for example.

Takizawa merely determines whether one of a plurality of battery packs provides a sufficient voltage. There is no determination of whether to maintain a processing ability or lower the processing ability based on the available electric power provided by the batteries.

Pole et al. uses a controller adapted to transition a component from a first performance mode to a lower activity state in response to a power management event. Specifically, Pole et

al. discloses that depending on the desired power consumption, the system may be set to one of multiple performance states. For example, if the system is powered by a battery, the system is placed in a lower performance state to conserve power. Alternatively, if the system is powered by an AC outlet, the system may be placed in a high performance state in which additional heat dissipation devices may be activated.

Thus, Pole et al. clearly does not teach "a processing ability determination section responsive to the removal requirement for a battery from said removal requirement receipt section to determine whether a supplying possible electric power from the remaining batteries is an electric power capable of maintaining a processing ability or electric power which needs to lower the processing ability." Pole does not contemplate a situation where one or more of a plurality of batteries is removed, while processing is carried on with the remaining batteries.

### **The Examiner's Acknowledged Use Of Hindsight**

On pages 14 and 15 of the Examiner's Amendment states:

"In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper."

Applicant disagrees with the Examiner's position that the use of hindsight reconstruction is appropriate.

The Supreme Court has long warned against the use of "hindsight" when determining obviousness. *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U.S. 428 (1911).

There are numerous lower court decisions criticizing improper use of hindsight. See ex. *Crown Operations International, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1376, 62 USPQ2d 1917 (Fed. Cir. 2002) (" 'Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.' *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998)."); *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351, 60 USPQ2d 1001 (Fed. Cir.

2001) ("The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some 'teaching, suggestion or reason' to combine cited references.")

In *In re Mahurkar Patent Litigation*, Judge Easterbrook noted "decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis. 831 F. Supp. 1354, 28 USPQ2d 1801 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 USPQ2d 1138 (Fed. Cir. 1995).

"It is impermissible to use the inventor's disclosure as a 'road map' for selecting and combining prior art disclosures" 2-5 Chisum on Patents § 5.03; *see also ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998) ("Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention."); *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988) ("Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.' ").

The Examiner goes on to state on page 15:

"In this case, examiner has provided reasoning as "lengthened the life of battery by triggering to lower performance state if usage is low" why one of ordinary skill in art would have been lead to combine these teachings. The factual support for the motivation can be found on column 6 in lines 36-38 of Pole reference."

This portion of Pole states:

"In addition, system usage may be monitored, with events generated to trigger switching to a lower performance state if usage is low, for example."

Applicant submits that this portion of Pole would not have lead one of ordinary skill to combine the teachings of Pole and Takizawa to achieve the present claimed invention. At most, it is submitted that one of ordinary skill would have been lead to modify Takizawa so that it is has different activity levels depending on (1) whether the electronic device is plugged into an AC

outlet or whether it is operating under battery control or (2) to switch to a lower state if usage is low.

**Claims 3, 15, 16 and 27 Are Directed To A Processing Ability Control Section Which Lowers The Processing Ability While Keeping The Electronic Apparatus Operative In Response To A Detection Of A Removal Of A Battery By The Mounting And Removal Detection Section**

On page 16 of the Examiner's Answer, the Examiner disagrees with the above-described interpretation of claims 3, 15, 16 and 27.

Claim 3 recites "a mounting and removal detection section detecting mounting and removal of batteries." Claim 3 further recites "a processing ability control section responsive to a detection of a removal of a battery by said mounting and removal section detection section to a lower a processing ability while keeping the electronic apparatus operative." Therefore, it is submitted the Examiner's analysis is incorrect and it is further submitted that claim 3 patentably distinguishes over the prior art.

**Conclusion and Summary**

Applicant submits that claims 1-42 patentably distinguish over the prior art. Reversal of the Examiner's rejection is respectfully requested.

Respectfully submitted,

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